

B. C. Cawfield

a main body portion; a shank extending from the main body portion; and a mounting hole formed in the shank to enable operative coupling of the saw blade to the retaining member,

the saw blade mounting hole extends in two dimensions, a length of extent in one dimension being greater than a length of the extent in the other dimension, and wherein the one dimension extends generally perpendicularly with respect to the other dimension.

14. (Twice Amended) An arrangement according to claim 10, wherein the length of extent is greater for the dimension parallel with a line of action of the saw blade in use than for a dimension perpendicular with the line of action of the saw blade in use.

REMARKS

Claims 1 through 19 remain pending in the present application. Claims 10 and 14 have been amended. Basis for the amendments can be found throughout the specification, claims and drawings as originally filed.

REJECTION UNDER 35 U.S.C. SECTION 112, second paragraph

The Examiner has objected to Claims 9 through 14 under 35 U.S.C. Section 112, second paragraph, alleging them to be indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner alleges that Claim 9 is vague and indefinite. Applicant would like to draw the

Examiner's attention to Figure 9, wherein two pairs of arms are illustrated. Clearly, this claim is supported in the specification and drawings.

With respect to Claims 10 and 14, Applicant has amended these claims to overcome the grammatical errors. Accordingly, Applicant believes the claims to now be in proper order and respectfully requests the Examiner's withdrawal of his Section 112, second paragraph, rejection.

2-7 **REJECTION UNDER 35 U.S.C. SECTION 102(b) and (e)**

The Examiner has rejected Claims 1-3, 8-11, 13 and 14 under 35 U.S.C. Section 102(b) and Claims 1-11, 13 and 14 under 35 U.S.C. Section 102(e) as being anticipated by Vannuvel and Huang, respectively. The Examiner alleges that Vannuvel discloses and claims Applicant's invention.

In order for a reference to be a proper 102(b) rejection, it requires:

Rejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference (cite omitted). Further, the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it (cite omitted). See In re Spada, 15 USPQ 2d 1655 at 1657.

Here, Claim 1 of Applicant's invention relates to a reciprocating shaft. The shaft includes a retaining member being lockable in at least two positions. Each of the at least two positions clamp the blade at a predetermined angle relative to the shaft.

The Vannuvel reference, as well as the Huang reference cited by the Examiner, fail to anticipate Applicant's invention. First, both of these references illustrate manual

saws which include handles attached to blades. Neither of these manual saws disclose or suggest a reciprocating shaft which would be mounted in a reciprocating saw as disclosed by Applicant. Accordingly, neither of these references describe Applicant's claimed invention sufficiently to have placed a person of ordinary skill in the art (the power reciprocating saw field) in possession of it. Accordingly, neither of these references is a proper reference under Section 102. Accordingly, neither reference cited by the Examiner discloses or suggests Applicant's invention. Accordingly, Applicant believes Claim 1 to be patentably distinguishable over the art cited by the Examiner. Accordingly, Claims 2 through 14 which depend from Claim 1 are patentably distinct over the art cited by the Examiner.

REJECTION UNDER 35 U.S.C. SECTION 103

The Examiner has rejected Claims 15 and 16 under 35 U.S.C. Section 103(a) alleging them to be unpatentable over Palm in view of Huang. The Palm reference illustrates a reciprocating saw. Huang, as discussed above, illustrates a manual hand saw. The combination of these two references fail to disclose or suggest Applicant's invention.

The court, in In re Fritch, 23 USPQ 2d 1780 at 1783 stated:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the

manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." at 1783 emphasis original.

Here, there is no suggestion or motivation that the hand saw of Huang could be or would be combined with the reciprocating saw of Palm. The Examiner has utilized Applicant's invention as a template in an attempt to piece together a rejection which would render Applicant's invention obvious. Accordingly, the Examiner cannot utilize this hindsight reconstruction in order to deprecate the claimed invention. Thus, Applicant believes Claims 15 and 16 to be patentably distinguishable over the art cited by the Examiner.

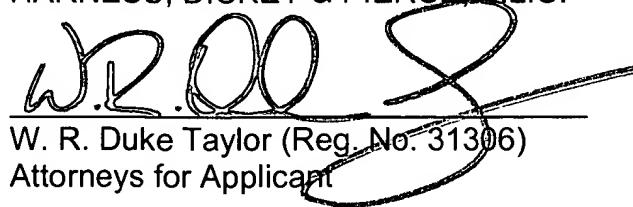
CONCLUSION

In light of the above amendments and remarks, Applicant would submit that all pending claims are in condition for allowance. Accordingly, Applicant respectfully requests the Examiner to pass the case to issue at his earliest possible convenience.

Should the Examiner have any questions regarding the present application, he should not hesitate to contact the undersigned at (248) 641-1600.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.


W. R. Duke Taylor (Reg. No. 31306)
Attorneys for Applicant

Dated: May 14, 2001

BY:

P.O. Box 828
Bloomfield Hills, Michigan 48303
Phone: (248) 641-1600

WRDT/kmg

ATTACHMENT FOR CLAIM AMENDMENTS

The following is a marked up version of each amended claim in which underlines indicates insertions and brackets indicate deletions.

10. (Twice Amended) An arrangement according to claim 1 [further comprising the blade for clamping between a saw blade,] wherein the saw blade further comprising:

a main body portion; a shank extending from the main body portion; and a mounting hole formed in the shank to enable operative coupling of the saw blade to the retaining member,

the saw blade [characterised in that the] mounting hole extends in two dimensions, [the] a length of [the] extent in one dimension being greater than [the] a length of the extent in the other dimension, and wherein the one dimension extends generally perpendicularly with respect to the other dimension.

14. (Twice Amended) An arrangement according to claim 10, wherein the length of extent is greater for the dimension parallel with a line of action of the saw blade in use than for a dimension perpendicular with [the direction of] the line of action of the saw blade in use.